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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/461,262	01/05/90	BARBERICH	T SPC8905
			EXAMINER
			SCHENKMAN, L
		ART UNIT	PAPER NUMBER
		125	9

HAMILTON, BROOK, SMITH & REYNOLDS  
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DATE MAILED: 03/22/91

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 12-24-90 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-12 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit 125

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-12 are rejected under 35 U.S.C. § 103 as being unpatentable over Chemical Abstracts for reasons of record. Applicants arguments regarding unpredictability are not persuasive in view of the cited decision.

Claims 1-5 are rejected under 35 U.S.C. § 103 as being unpatentable over Brittain et al, Hartley et al, Hawkins et al and Buckner et al who teach compositions containing the claimed compounds (e.g water or saline solution) and its isomers used as a bronchodilation<sup>3f</sup> in the treatment of asthma. The references further teach greater bronchodilation activity of the R (-) isomer over the S(+) isomer. The use therefor, of composition<sup>✓</sup> containing naimly the R (-) isomer in the treatment of asthma is clearly rendered obvious by the prior art.

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Claims 6-12 are rejected under 35 U.S.C. § 103 as being unpatentable over the references supra in further view of Chemical Abstracts which shows combination of drugs, including salbutomal, used in the treatment of asthma.

Claims 6 and 9-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. No basis for the mixture of isomers set forth in claims 10 and 11 can be found in claim 9 which is limited to a single isomer. Claim 9 is incorrect is not including the R(-) isomer. Compare with original claim 9. Claims 9-12 are again deemed to be too broad absent proportions of ingredients. The term "additional drug" (claims 6 and 9-11) is too broad.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. Schenkman whose telephone number is (703) 308-0091.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.



LEONARD SCHENKMAN  
EXAMINER  
ART UNIT 125

SCHENKMAN:drb  
March 13, 1991